

Amendments to the Drawings:

The drawings submitted herewith include new Figures 6, 7, 8(a), 8(b), and 8(c). Attached hereto are new sheets showing these figures.

REMARKS

Please note the fact that September 9, 2006, fell on a Saturday ensures that this paper is timely filed as of today, Monday, September 11, 2006 (the next succeeding day which is not a Saturday or Sunday).

In the Office Action dated March 9, 2006, pending Claims 13-19, 21 and 27-37 were rejected and the rejection made final; Claims 13, 19 and 27 are independent and Claims 14-18, 21 and 28-37 are dependent. Applicant has filed herewith an a Request for Continued Examination and an Amendment amending the specification, amending claims 18, 19, 21, 27 and 28 and canceling claim 20, 5 new drawing sheets with new Figures 6, 7, 8(a), 8(b) and 8(c), Exhibit 1: a copy of Examiner Newhouse's Restriction Requirement in Application Serial Number 09/919,775, Exhibit 2: a copy of Ibis Tek's online brochure for "HMMWV Rear Bumper Kit".

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Examiner is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the foregoing amendments and following remarks. Amendments have been made to correct informalities in the claims and to clarify claim language. Applicant intends no change in the scope of the claims by the changes made by this amendment. It should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

New Drawings and Amendments to the Specification:

Submitted herewith are new drawings Figures 6, 7, 8(a), 8(b), 8(c) and amendments to the Specification reflecting the new drawings. Applicant respectfully submits that no new matter has been added and that these changes are supported by the original disclosure, drawings and claims under MPEP § 608.04.

Objections to the Drawings:

The Examiner has objected to the Drawings under 37 C.F.R. § 1.83(a) for failing to depict claimed subject matter and for other informalities.

Examiner objects to the Drawings stating that movement about vertical and horizontal axes is not shown in the Drawings. Applicant respectfully points out that Figure 3 does support such claim language. Figure 3 depicts arm 100 pivotally attached to vehicle bumper 70 at pivot point 110. This results in rotation about a vertical axis. Figure 3 also depicts pivot arm 130

pivotaly attached to arm 100 at second pivot point 140. This results in rotation about a horizontal axis. In any event, Applicant has added new Figures 8(a), 8(b) and 8(c), which provide further detail as to the movement of tire carrier. As can be seen in Figure 8(a) arm 100 swings away from vehicle bumper 70 about a vertical axis through point 110 as indicated by arrow A1. This is rotation about a vertical axis. As can be seen in Figure 8(b) pivot arm swings down from arm 100 about a horizontal axis through second point 140 as indicated by arrow A2. This is rotation about a horizontal axis. Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to the Drawings stating that material extending past the at least one lug is not shown in the Drawings. Applicant has added new Figure 6. Figure 6 shows a partial top view of the tire carrier with tire spinner 170 and lugs 160A, 160B and 160C attached to tire support 150. As can be seen from Figure 6 tire spinner 170 extends from tire support 150 past the length of lugs 160A, 160B and 160C. Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to the Drawings stating that the material extending about 240° and 360° is not shown in the Drawings. Applicant respectfully points out that Figure 5 depicts the tire spinner 170 extending for approximately 2/3rds of its total circumference or about 240°. Applicant has also added new Figure 7, which shows a partial front view of the tire carrier with the tire removed and provided further detail. As can be seen in Figure 7 tire spinner 170 extends for approximately 2/3rds of its total circumference or about 240°. A dashed arc segment is also shown in Figure 7, which is meant to depict tire spinner 170 extending for its full circumference or 360°. Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to the Drawings stating that movement of the tire above the ground and the tire contacting the ground is not shown. Applicant has added new Figures 8(a), 8(b) and 8(c), which show movement of the tire carrier in the open position. Figure 8(a) shows the tire 220 in a fully raised position after arm 100 has been swung away from vehicle bumper 70. Figure 8(b) shows the tire 220 between raised and lowered positions as the pivot arm is being lowered about second point 140 by cable 210. Figure 8(c) shows tire 220 in a lowered position contacting the ground (indicated by hatching). Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to the Drawings stating that the length of the at least one lug less than the length of the supporting material is not shown in the Drawings. Applicant has added Figure 6 as previously discussed. Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to the Drawings stating that the electrical winch must be shown. Applicant respectfully submits that conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawings in the form of a graphical drawing symbol or labeled representation. 37 C.F.R. § 1.83(a). Applicant respectfully traverses the Examiner's objection and submits that the drawings are in compliance with 37 C.F.R. § 1.83(a). Figure 3 depicts winch 200. The specification at page 12 line 19-page 13 line 8 provides detail as to winch 200 stating that winch 200 may be either manual or electric. Applicant respectfully submits that Figure 3 adequately depicts winch 200. An electric winch is disclosed and detailed illustration is not essential for a proper understanding of the invention as those in the art would readily understand from Figure 3 and the specification that an electric winch may be used in the current invention. Those in the art would surely be familiar enough with the operation of an electric winch such that detailed illustration would not be essential for them to properly understand Applicant's invention. Applicant respectfully submits that the Drawings depict the claimed subject matter and respectfully requests that the Examiner withdraw this objection.

Examiner objects to Figure 3 stating that Applicant's invention is inoperative in this Figure because tire support is connected to the back of pivot arm 130 and therefore must interfere with arm 100 when pivot arm 130 is rotated upward. Applicant respectfully traverses this objection. Applicant previously addressed a similar objection made by the Examiner in a prior Office Action in the Response dated December 21, 2005. Those remarks apply with equal force to this objection and are hereby fully incorporated into this Response. As can be understood from the Specification, Figure 3 and Applicant's prior remarks pivot arm 130 scissors past arm 100 with tire support 150 attached. Tire support 150 does not inhibit the motion of pivot arm 130. Figure 6 shows a top view of the tire carrier. As can be clearly seen from Figure 6 pivot arm lies in a plane parallel to the plane of arm 100. Tire support 150 is attached to pivot arm 130 on the **top side** of pivot arm 130 and does not hinder the motion of pivot arm 130 with respect to interfering with arm 100. Figures 8(a)-8(c) further detail the motion of pivot arm 130 and tire

support 150. Examiner's attention is directed toward Exhibit 2: Ibis Tek's online brochure for a "HMMWV Rear Bumper Kit", which depicts a commercial embodiment of the current invention. As can be seen from the three photographs on the right hand side of page 1 the tire support does not interfere with the motion of the pivot arm. Applicant respectfully submits that the current invention is most certainly operative and respectfully requests that the Examiner withdraw this objection.

Examiner objects to Figure 5 stating that various elements are not clearly represented and asks that a detailed drawing showing swing arm 130 and tire support 150 be provided. Applicant respectfully traverses this objection. Applicant is not aware of any requirement that the invention be fully depicted in each and every drawing. In fact such a requirement would defeat the purpose of sectional, partial, and enlarged detail drawing views commonly utilized in patent applications. It can be understood from Figure 5 that in the closed position shown, pivot arm 130 is in front of arm 100 and ends at a point behind tire 220. Such that pivot arm 130 is visible on one side of tire 220 while arm 100 is visible on the other side of tire 220. It can also be understood that tire support 150 is behind tire 220 and is not seen in this view. Figure 3 shows a detailed view of pivot arm 130 and tire support 150. Figure 5 can be readily understood in conjunction with Figure 3. New Figures 6, 7, 8(a), 8(b) and 8(c) provide further detail concerning the pivot arm 130 and tire support 150. Applicant respectfully submits that Figure 5 is clearly represents certain features and elements of the current invention and is readily understandable when viewed in conjunction with the other Figures and the Specification and respectfully requests that the Examiner withdraw this objection.

Rejection for Non-Statutory Obviousness-Type Double Patenting based upon U.S. Patent 6,613,834 in view of Jozefczak ('371):

Claims 13, 15-19, 21, and 27-32 stand rejected on the grounds of Non-Statutory Obviousness-Type Double Patenting over claims 1-5 of Applicant's prior patent USPT 6,613,834 in view of USPT 5,186,371 to Jozefczak (hereinafter Jozefczak ('371)).

Applicant respectfully submits that double patenting rejections are **prohibited** under 35 U.S.C. § 121 in Divisional Applications where a Restriction Requirement was made in the prior application. MPEP § 804.01.

The current application for patent is a divisional application from Applicant's prior application, which became USPT 6,613,834. In the prior application Examiner Newhouse made

a Restriction Requirement requiring Applicant to elect between claims in Group 1 drawn to an apparatus for carrying a spare tire hingedly mounted to a vehicle and claims in Group 2 drawn to a tire support for carrying a spare tire on the grounds that claim Groups 1 and 2 were related as Combination/Sub-combination claims and that the claims drawn to the sub-combination had separate utility and that the claims drawn to the sub-combination did not require the particulars of the sub-combination as claimed. A copy of Examiner Newhouse's Restriction Requirement made in the Office Action dated September 25, 2002 is submitted herewith as Exhibit 1.

Applicant elected to prosecute those claims directed towards Group 1 and received a patent on those claims. Applicant then filed this divisional application with claims directed toward Group 2 established by Examiner Newhouse, which was non-elected in the prior application. As such Applicant's current application is properly considered a **Divisional Application** of the prior application that Examiner uses as the basis for a rejection of the current claims for non-statutory obviousness-type double patenting. Applicant respectfully submits that rejection of the current claims for non-statutory obviousness-type double patenting is therefore **prohibited** under 35 U.S.C. § 121 and MPEP § 804.01 and respectfully traverses the rejection on those grounds. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13, 15-19, 21, and 27-32 for non-statutory obviousness-type double patenting.

Rejections under 35 U.S.C. § 112, 1st paragraph:

Claims 13-21, 27 and 28 stand rejected under 35 U.S.C. § 112, 1st paragraph for failing to meet the written description requirement.

Applicant respectfully submits with regard to the written description requirement that the description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. MPEP § 2163.04. The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. MPEP § 2163(II)(3)(b). The fundamental issue being whether the specification conveys with reasonable clarity to those of ordinary skill in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. The subject matter of the claims need not be described literally (i.e., using the same terms or *ad haec verba*) in order for the disclosure to satisfy the written description requirement. MPEP § 2163.02. Rather, to comply with the written description requirement under 35 U.S.C. § 112, 1st paragraph

each claim limitation must be expressly, implicitly, or inherently supported in the original disclosure. MPEP § 2163(II)(3)(b).

Claims 13-21 stand rejected under the written description requirement of 35 U.S.C. 112 1st paragraph because, according to the Examiner the specification does not adequately support claim limitations drawn towards the tire support being capable of movement about horizontal and vertical axes. Applicant previously addressed a rejection of a similar nature made in a prior Office Examiner in the Response dated December 21, 2005. Those remarks apply with equal force to this rejection and are hereby fully incorporated into this Response. As is shown in Figure 3 and related in the original disclosure tire support 150 is attached to pivot arm 130. Pivot arm 130 is pivotally attached to arm 100 at second point 140 so that pivot arm 130 rotates about a horizontal axis passing through second point 140. Tire support 150, being attached to pivot arm 130, also moves about this same horizontal axis when pivot arm 130 is rotated. Arm 100 is pivotally attached to vehicle bumper 70 at point 110 so that arm rotates about a vertical axis passing through point 110. Tire support 150, being attached to arm 100 through pivot arm 130, also moves about this same vertical axis when arm 100 is rotated. The Examiner says as much in the current rejection. Applicant respectfully submits that the original disclosure is more than sufficient to convey the claimed limitations just as the Examiner points out. Just because the exact phrase “movement about” was not previously used in the disclosure does not mean the specification does not satisfy the written description requirement with respect to that claim terminology. MPEP § 2164.02. Examiner’s current rejection is seemingly based on the fact that tire support 150 is fixedly attached to pivot arm 130 and therefore is incapable of movement about any axes. Examiner’s rejection, then, would seemingly be more properly categorized as a rejection under 35 U.S.C. § 112, 2nd paragraph for using claim terminology (i.e., “movement about”) inconsistent with its ordinary meaning or without any special identification in the disclosure. With respect to such a rejection Applicant respectfully submits that applicants are their own lexicographers and can define in the claims what they regard as their invention in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. A claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. MPEP § 2173.01. Applicant respectfully submits that the claim terminology “movement about” is fully consistent with the original disclosure as was previously discussed and attaches no special or unordinary meaning to

the claim terms. The term “about” is commonly used in association with rotational movement. As can be seen from the disclosure, the figures, and Ibis Tek’s online brochure submitted herewith as Exhibit 1 tire support 150 does **move** from a position wherein tire 220 is lowered from arm 100 as shown in Figure 3 to a position where tire 220 is stored on the rear of a vehicle as shown in Figure 5. The movements of tire support 150 are **centered** upon second point 140 as tire support 150 is being raised or lowered and upon point 110 as tire support 150 is being placed on or removed from a vehicle such that the movement of tire support 150 is essentially **rotational** in nature. Hence, “movement about” the axes passing through point 110 and second point 140. One of ordinary skill in the art would readily understand this claim terminology in light of the specification and drawings. If the Examiner has claim terminology in mind that he believes would better suit the current invention and not change the scope of the current claims, Applicant is willing to consider the Examiner’s suggestions. *See* MPEP § 2164.04(I). Applicant respectfully submits that the claim terminology particularly points out and distinctly claims the subject matter the Applicant regards as the invention and is fully supported by the original disclosure. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-21 under 35 U.S.C. § 112, 1st paragraph for failing to satisfy the written description requirement.

Claims 13-21 stand rejected under the written description requirement of 35 U.S.C. 112 1st paragraph because, according to the Examiner, the specification does not adequately support claim limitations due to the stated inoperability of the current invention. Applicant respectfully submits that the Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a **strong presumption** that an adequate written description of the claimed invention is present in the specification as filed. MPEP § 2163(II)(A). Examiner states that claims 13-21 are not supported by the written description because the current invention, as depicted in Figure 3, is inoperative because tire support 150 is attached to the back side of pivot arm 130 so as to interfere with the movement of pivot arm 130 in rotating through second point 140 into a parallel relationship with arm 100. Applicant’s specification describes the motion of pivot arm 130 in conjunction with Figure 3 in the paragraph beginning at page 12 line 12 and describes attachment of tire support 150 to pivot arm 130 in conjunction with Figure 3 in the paragraph

beginning at page 13 line 9. Applicant can find **no mention** in these paragraphs that tire support 150 is attached to the back side of pivot arm 130 or somehow prevents pivot arm from moving parallel to arm 100. A **more reasonable** viewing of Figure 3, then, in light of the **strong presumption** that the written description is adequate to support the claimed invention would indicate that tire support 150 is attached to pivot arm 130 at the **top side** of pivot arm 130 or is attached to pivot arm 130 in some other manner so as to not interfere with motion of pivot arm 130. MPEP § 2164.08(b) addresses the issue of inoperative subject matter with regards to the Enablement Requirement under 35 U.S.C. § 112, 1st paragraph. As indicated in MPEP § 2164.08(b), even if the embodiment of Figure 3 were somehow inoperative, as the Examiner asserts, that is not enough to sustain a rejection under 35 U.S.C. § 112, 1st paragraph. Claimed subject matter is still enabled by an inoperative embodiment if one of ordinary skill in the art can achieve an operative embodiment without undue experimentation or the expenditure more effort than is normally required in the art. MPEP § 2164.08(b). One of ordinary skill could **easily** come up with an operative embodiment of the current invention just by determining a point of attachment for tire support 150 that does not interfere with the motion of pivot arm 130 with respect to arm 100. This could be done by spot welding tire support 150 to pivot arm 130 at a particular point or even just holding or clamping tire support 150 to pivot arm 130 and then moving pivot arm 130 up and down with respect to arm 100. No undue experimentation or excessive effort would be required. MPEP § 2164.08(b). To further clarify the matter, Applicant has provided new Figures 6, 8(a), 8(b) and 8(c) in the current Response. Figure 6 depicts a top view of the tire carrier of the current invention. As can be seen from Figure 6, tire support 150 is not attached to the back side of pivot arm 130 in a manner that would interfere with the motion of pivot arm 130. Figures 8(a)-(c) depict the motion of the pivot arm 130 about second point 140. As can be seen from these Figures, tire support 150 **does not** interfere with the motion of pivot arm 130. Applicant has also provided a copy of an online brochure (available at <http://www.ibistek.com/pdfs/MASTC.pdf>) for a commercial embodiment of the current invention with this Response as Exhibit 2. As can be seen from the photographs on the right hand side of page 1 of the brochure the tire support is attached to the **top side** of the pivot arm and does not interfere with the pivot arm's motion. Applicant respectfully submits that the claimed invention is fully supported by the written description and fully enabled under 35 U.S.C. § 112, 1st paragraph as established above. Applicant respectfully requests that the Examiner withdraw

the rejection of claims 13-21 as failing to comply with the written description requirement of 35 U.S.C. § 112, 1st paragraph.

Claim 21 stands rejected under the written description requirement of 35 U.S.C. 112 1st paragraph because, according to the Examiner, the specification does not adequately support claim limitations, specifically “the material provides support throughout at least a major portion of the interior opening in the rim,” which the Examiner considers to be new matter. Applicant respectfully traverses this rejection. As stated above, the subject matter of the claims need not be described literally in the written disclosure to satisfy the written description requirement. MPEP § 2163.02. Claimed subject matter can be supported by the original disclosure expressly, implicitly or inherently. MPEP § 2163(II)(3)(b). Applicant respectfully submits that the claimed subject matter of claim 1 is adequately supported by the original disclosure. The specification provides the following at page 14 line 18-page 15 line 4:

As shown, tire spinner 170 is circular in nature and is solid for approximately two-thirds of a circle. This is a design choice which uses less material. The important consideration is for tire spinner 170 to extend far enough around in circumference to meaningfully connect with the interior opening in the rim of tire 220 when pivot arm 130 is in the lowered position. Indeed, there is no reason why tire spinner 170 could not have an unbroken circumference.

Figure 5 visually demonstrates the above subject matter. As can be seen from Figure 5 and understood from the above excerpt of the Specification, tire spinner 170 (or “material”) extends about its own circumference for approximately 2/3rds of circle so as to meaningfully connect with the interior opening of the rim of tire 220. The interior opening of the rim of a tire extends about its own circumference for a full circle. Thus the tire spinner connects with and “provides support” to the interior opening for more than half of the circumference of the interior opening of the rim of tire 220 or “at least a major portion of the interior opening in the rim.” Figure 5 shows tire support 150 connecting with and providing support for the interior opening for a major portion of the interior opening. As such, the written disclosure, at the very least, provides inherent support for the subject matter of claim 21. For the foregoing reasons Applicant respectfully submits that the subject matter of claim 21 satisfies the written description requirement of 35 U.S.C. § 112, 1st paragraph. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 as failing to comply with the written description requirement of 35 U.S.C. § 112, 1st paragraph.

Claim 27 stands rejected under the written description requirement of 35 U.S.C. 112 1st paragraph because, according to the Examiner, the specification does not adequately support claim limitations, specifically “a tire support affixed to a distal end of a pivot arm,” which the Examiner considers to be new matter. Applicant respectfully traverses this rejection. As stated above, the subject matter of the claims need not be described literally in the written disclosure to satisfy the written description requirement. MPEP § 2163.02. Claimed subject matter can be supported by the original disclosure expressly, implicitly or inherently. MPEP § 2163(II)(3)(b). Applicant respectfully submits that the claimed subject matter of claim 1 is adequately supported by the original disclosure. As can be seen in Figure 3 tire support 150 is attached to pivot arm 130 at the end of pivot arm 130 **away from** second point 140 where pivot arm 130 is attached to arm 100, hence “affixed to a distal end of a pivot arm.” Applicant respectfully submits that the subject matter of claim 27 is fully consistent with the written disclosure as depicted in Figure 3 and with the common meaning of the word “distal.” As such, the written disclosure, at the very least, provides inherent support for the subject matter of claim 27. For the foregoing reasons Applicant respectfully submits that the subject matter of claim 27 satisfies the written description requirement of 35 U.S.C. § 112, 1st paragraph. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 as failing to comply with the written description requirement of 35 U.S.C. § 112, 1st paragraph.

Rejections under 35 U.S.C. § 112, 2nd paragraph:

Claims 18 and 27-37 stand rejected under 35 U.S.C. § 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 18 stands rejected under 35 U.S.C. § 112, 2nd paragraph for use of claim terminology “meaningfully connect,” which the Examiner considers to be confusing and unclear. Claim 18 has been amended to delete the word “meaningfully.” Applicant respectfully submits that the claim terminology “extent to connect” is clear and is adequately defined in the specification. Applicant respectfully submits that claim 18, as amended, particularly points out and distinctly claims the subject matter that Applicant regards as the invention. Applicant respectfully requests that the Examiner withdraw the rejection of claim 18 under 35 U.S.C. § 112, 2nd paragraph.

Claim 27, and presumably claims 28-37 with it, stands rejected under 35 U.S.C. § 112, 2nd paragraph for use of claim terminology “tire spinner affixed to a tire support affixed to a distal end of a pivot arm,” which the Examiner considers to be confusing and unclear because it is unclear whether the spinner or the support is affixed to the distal end of the pivot arm. Claim 27 has been amended to state: “tire spinner affixed to a tire support, said tire support affixed to a distal end of a pivot arm.” Applicant respectfully submits that this claim terminology is clear as to the interrelationship of the elements and is adequately defined in the specification. Applicant respectfully submits that claim 27, as amended, particularly points out and distinctly claims the subject matter that Applicant regards as the invention. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 under 35 U.S.C. § 112, 2nd paragraph.

Claim 28 stands rejected under 35 U.S.C. § 112, 2nd paragraph for omitting the element of a winch for support of the tire spinner in a plurality of raised positions, which, according to the Examiner, is an omitted essential element amounting to a gap between elements. Claim 28 has been amended to state: “said tire spinner capable of maintaining support for said tire at any position of which said tire support can move about said horizontal axis.” Applicant believes this claim terminology will better define the claimed subject matter. With regards to the winch being an omitted essential element, Applicant is confused and unclear as to the meaning of the Examiner’s rejection. Does the Examiner mean to say the winch is disclosed to be essential to the invention and therefore claim 28 is not enabled under 35 U.S.C. § 112, 1st paragraph? Or does the Examiner mean to say that claim 28 fails to interrelate essential elements of the invention as defined by Applicant in the Specification resulting in a failure to particularly point out and distinctly claim the subject matter Applicant regards as the invention under 35 U.S.C. § 112, 2nd paragraph? *See* MPEP § 2172.01. With regards to the former possibility, the Examiner’s attention is directed toward the Specification at page 13 lines 6-8, which states:

It should be noted that while a cable and winch arrangement is presently preferred, a handle or similar device may also be attached at attachment point 190 to facilitate manual operation.

As can be seen from the above excerpt a winch is **expressly** disclosed to not be essential to the invention and therefore the Applicant respectfully submits that claim 28 is fully enabled by the Specification under 35 U.S.C. § 112, 1st paragraph. With regards to the latter possibility, Applicant respectfully submits that claims do not automatically fail to particularly point out and

distinctly claim the subject matter regarded as the invention just because elements are not made interdependent or are not directly functionally related. MPEP § 2172.01. The subject matter of claim 28, as amended, deals with the capability of the tire spinner to support the tire throughout the movement of the tire support from a raised position where the tire is above the ground and a lowered position where the tire contacts the ground. Claim 28 depends from claim 27, which already interrelates the tire spinner, the tire support and the tire. The winch is not involved with the interrelation of these elements. A winch can be used to lift the tire support but, as discussed above, the winch is not essential for lifting the tire support. For the foregoing reasons, Applicant respectfully submits that this claim terminology is clear as to the interrelationship of the elements and is adequately defined in the specification. Applicant respectfully submits that claim 28, as amended, particularly points out and distinctly claims the subject matter that Applicant regards as the invention. Applicant respectfully requests that the Examiner withdraw the rejection of claim 28 under 35 U.S.C. § 112, 2nd paragraph for the omission of essential elements.

Rejection of claims 13-21 and 27-30 under 35 U.S.C. § 102(b) over Mrozowski ('192):

Claims 13-21 and 27-30 stand rejected as being anticipated by U.S. Patent 5,183,192 to Mrozowski et al. (hereinafter Mrozowski ('192)) under 35 U.S.C. § 102(b).

Broadly, Mrozowski ('192) discloses a spare tire lowering system comprising a primary rack hingedly attached to the right rear corner of a vehicle body. Hingedly attached to the primary rack is a secondary rack. The secondary rack carries a spare tire on a mounting box located in the center of the secondary rack. The center of the rim of the tire is mounted over a frusto-conical hub projecting from the mounting box. The rim is secured to the mounting box by a lock nut that engages a threaded shaft projecting from the mounting box and through the rim. In operation the spare tire is lowered by swinging the secondary rack away from the primary rack so as to rotate the tire 180° (Figures 1 & 2, and col. 2 line 26-col. 3 line 53).

Applicant respectfully submits that a claim is anticipated under § 102 only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference (MPEP § 2131). Applicant respectfully submits that the disclosure in Mrozowski ('192) is not sufficient anticipate independent claims 13, 19 and 27 under § 102.

With regards to independent claim 13, the claim recites the limitation of "material extending past a lug which supports the tire in a manner to permit the tire to rotate and be aligned with the lug, wherein said material is **capable of supporting the tire throughout the positions**

through which said tire support can travel about the horizontal axis, thereby enabling tire rotation at any of the positions.” Applicant respectfully submits that Mrozowski ('192) does not disclose this claimed subject matter. Mrozowski ('192) discloses a tire support having a frusto-conical hub extending therefrom that may be capable of supporting the spare tire. However, as can be seen in Figure 2 of Mrozowski ('192) the mounting box (and the tire mounted to it) rotates along with the secondary rack 180°. The assembly literally **flips** downward as indicated by the arrow in Figure 2 such that while in the raised position the frusto-conical hub faces toward the rear of the vehicle and while in the lowered position the frusto-conical hub faces toward the **front** of the vehicle (Figure 2 and col. 2 lines 41-53). Meaning at some point during the rotation of the mounting box about the hinge points of the secondary rack the mounting box and the frusto-conical hub are pointing **downward** and the tire must therefore be oriented **parallel** to the ground. At this point the frusto-conical hub is completely **incapable** of providing any support for the tire. The sole means of keeping the tire on the mounting box is the lock nut and threaded shaft. Moreover, a user **cannot** rotate the tire at this position because doing so would require removing the lock nut and the threaded shaft which would cause the tire to **fall off the mounting box** and onto the ground. Mrozowski ('192), then, fails to disclose the claimed subject matter because the frusto-conical hub does not support the tire or enable tire rotation throughout the positions through which the mounting box travels. Applicant respectfully submits that claim 13 is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 13 for being anticipated by Mrozowski ('192) under § 102(b). Claims 14-18 are all dependent upon independent claim 13 and are allowable over Mrozowski ('192) for at least the same reasons as claim 13. Applicant respectfully requests that the Examiner withdraw the rejections of claims 14-18 for being anticipated by Mrozowski ('192) under § 102(b).

With regards to independent claim 19, the claim has been amended to incorporate the subject matter of claim 20. Claim 20 has been cancelled. Claim 19, as amended, recites claim limitations as to material extending past a lug which supports a tire in a manner to permit the tire to rotate and be aligned with the lug, the support being provided throughout the positions through which a pivot arm can travel about a horizontal axis, thereby enabling tire rotation at any of the positions. Applicant respectfully submits that Mrozowski ('192) does not disclose this claimed subject matter. As discussed above with regards to claim 13, the apparatus disclosed by

Mrozowski ('192) **flips** downward through 180° (Figure 2, col. 2 lines 41-53). As a result, during the travel of the secondary rack about its pivoting axis the mounting box and the frusto-conical come to be pointing **downward** at a certain point in the motion of the secondary rack with the tire being oriented **parallel** to the ground. At this point the frusto-conical hub is completely **incapable** of providing any support for the tire. The sole means of keeping the tire on the mounting box is the lock nut and threaded shaft. Moreover, a user **cannot** rotate the tire at this position because doing so would require removing the lock nut and the threaded shaft which would cause the tire to **fall off the mounting box** and onto the ground. Mrozowski ('192), then, fails to disclose the claimed subject matter because the frusto-conical hub does not support the tire or enable tire rotation throughout the positions through which the secondary rack travels. Applicant respectfully submits that claim 19, as amended, is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 19 for being anticipated by Mrozowski ('192) under § 102(b). Claim 21 is dependent upon independent claim 19 and is allowable over Mrozowski ('192) for at least the same reasons as claim 19. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 for being anticipated by Mrozowski ('192) under § 102(b).

With regards to independent claim 27, the claim recites the limitation of "a tire support affixed to a distal end of a pivot arm." Applicant respectfully submits that Mrozowski ('192) does not disclose this claimed subject matter. Mrozowski ('192) discloses a mounting box affixed to a secondary rack **in the middle of the rack** not at a **distal end**. This can be clearly seen in Figures 1 and 2 of Mrozowski ('192). The specification of Mrozowski ('192) further states that "the [mounting] box connects the **intermediate** segments of two angularly disposed U-shaped members . . . of the secondary rack (col. 2 lines 43-45)." As such, Mrozowski ('192) fails to disclose a tire support affixed to a distal end of a pivot arm. Applicant respectfully submits that claim 27 is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 for being anticipated by Mrozowski ('192) under § 102(b). Claims 28-30 are dependent upon independent claim 27 and are allowable over Mrozowski ('192) for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejections of claims 28-30 for being anticipated by Mrozowski ('192) under § 102(b).

Rejection of claims 13-21 and 27-30 under 35 U.S.C. § 103(a) over Mrozowski ('192):

Claims 13-21 and 27-30 stand rejected as being unpatentable over Mrozowski ('192) under 35 U.S.C. § 103(a).

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

With regards to independent claim 13, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "material extending past a lug which supports the tire in a manner to permit the tire to rotate and be aligned with the lug, wherein said material is capable of supporting the tire throughout the positions through which said tire support can travel about the horizontal axis, thereby enabling tire rotation at any of the positions." Examiner states that it would have been obvious to one of ordinary skill in the art to provide a frusto-conical hub on the mounting box of Mrozowski ('192) that passes the length of the threaded shaft. Even with such a modification Mrozowski ('192) will still fail to teach or suggest all of the claim limitations. MPEP § 2143. Even if lengthened, the frusto-conical hub of Mrozowski ('192) will still not support the tire or enable tire rotation throughout the positions through which the mounting box travels because of the flipping motion of the mounting box. Applicant respectfully submits that claim 13 is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 13 for being unpatentable over Mrozowski ('192) under § 103(a). Claims 14-18 are all dependent upon independent claim 13 and are allowable over Mrozowski ('192) for at least the same reasons as claim 13. Applicant respectfully requests that the Examiner withdraw the rejections of claims 14-18 for being unpatentable over Mrozowski ('192) under § 103(a).

With regards to independent claim 19, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of material extending past a lug which supports a tire in a manner to permit the tire to rotate and be aligned with the lug, the support being provided throughout the positions through which a pivot arm can travel about a horizontal axis, thereby enabling tire rotation at any of the positions. Examiner states that it would have been obvious to

one of ordinary skill in the art to provide a frusto-conical hub on the mounting box of Mrozowski ('192) that passes the length of the threaded shaft. Even with such a modification Mrozowski ('192) will still fail to teach or suggest all of the claim limitations. MPEP § 2143. Even if lengthened, the frusto-conical hub of Mrozowski ('192) will still not support the tire or enable tire rotation throughout the positions through which the secondary rack travels because of the flipping motion of the secondary rack. Applicant respectfully submits that claim 19, as amended, is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 19 for being unpatentable over Mrozowski ('192) under § 103(a). Claim 21 is dependent upon independent claim 19 and is allowable over Mrozowski ('192) for at least the same reasons as claim 19. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 for being unpatentable over Mrozowski ('192) under § 103(a).

With regards to independent claim 27, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "a tire support affixed to a distal end of a pivot arm." Examiner states that it would have been obvious to one of ordinary skill in the art to provide a frusto-conical hub on the mounting box of Mrozowski ('192) that passes the length of the threaded shaft. Even with such a modification Mrozowski ('192) will still fail to teach or suggest all of the claim limitations. MPEP § 2143. The mounting box of Mrozowski ('192) will still be located **in the middle** of the secondary rack. Not at an **end** of the secondary rack. Applicant respectfully submits that claim 27 is allowable over Mrozowski ('192) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 for being unpatentable over Mrozowski ('192) under § 103(a). Claims 28-30 are dependent upon independent claim 27 and are allowable over Mrozowski ('192) for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejections of claims 28-30 for being unpatentable over Mrozowski ('192) under § 103(a).

Rejection of claims 13-21 and 27-30 under 35 U.S.C. § 103(a) over Mrozowski ('192) in view of Hansen ('717):

Claims 13-21 and 27-30 stand rejected as being unpatentable over Mrozowski ('192) in view of U.S. Patent 4,679,717 to Hansen (hereinafter Hansen ('717)) under 35 U.S.C. § 103(a).

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or

combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

With regards to independent claim 13, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "material extending past a lug which supports the tire in a manner to permit the tire to rotate and be aligned with the lug, wherein said material is capable of supporting the tire throughout the positions through which said tire support can travel about the horizontal axis, thereby enabling tire rotation at any of the positions." Examiner states that it would have been obvious to one of ordinary skill in the art to provide an arcuate rest as taught by Hansen ('717) on the mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Hansen ('717) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The arcuate rest taught by Hansen ('717), when placed on the mounting box of Mrozowski ('192), will not support the tire or enable tire rotation throughout the positions through which the mounting box travels because of the flipping motion of the mounting box (*See* Figure 1 of Hansen ('717)). In this regard, the arcuate rest taught by Hansen ('717) provides no more, and perhaps less, functionality than the frusto-conical hub taught by Mrozowski ('192). Applicant respectfully submits that claim 13 is allowable over Mrozowski ('192) and Hansen ('717) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 13 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a). Claims 14-18 are all dependent upon independent claim 13 and are allowable over Mrozowski ('192) and Hansen ('717) for at least the same reasons as claim 13. Applicant respectfully requests that the Examiner withdraw the rejections of claims 14-18 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a).

With regards to independent claim 19, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of material extending past a lug which supports a tire in a manner to permit the tire to rotate and be aligned with the lug, the support being provided throughout the positions through which a pivot arm can travel about a horizontal axis, thereby enabling tire rotation at any of the positions. Examiner states that it would have been obvious to one of ordinary skill in the art to provide an arcuate rest as taught by Hansen ('717) on the

mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Hansen ('717) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The arcuate rest taught by Hansen ('717), when placed on the mounting box of Mrozowski ('192), will not support the tire or enable tire rotation throughout the positions through which the secondary rack of Mrozowski ('192) travels because of the flipping motion of the secondary rack (*See* Figure 1 of Hansen ('717)). In this regard, the arcuate rest taught by Hansen ('717) provides no more, and perhaps less, functionality than the frusto-conical hub taught by Mrozowski ('192). Applicant respectfully submits that claim 19, as amended, is allowable over Mrozowski ('192) and Hansen ('717) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 19 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a). Claim 21 is dependent upon independent claim 19 and is allowable over Mrozowski ('192) and Hansen ('717) for at least the same reasons as claim 19. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a).

With regards to independent claim 27, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "a tire support affixed to a distal end of a pivot arm." Examiner states that it would have been obvious to one of ordinary skill in the art to provide an arcuate rest as taught by Hansen ('717) on the mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Hansen ('717) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The mounting box of Mrozowski ('192) will still be located **in the middle of** the secondary rack. Not at an **end** of the secondary rack. Applicant respectfully submits that claim 27 is allowable over Mrozowski ('192) and Hansen ('717) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a). Claims 28-30 are dependent upon independent claim 27 and are allowable over Mrozowski ('192) and Hansen ('717) for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejections of claims 28-30 for being unpatentable over Mrozowski ('192) in view of Hansen ('717) under § 103(a).

Rejection of claims 13-21 and 27-30 under 35 U.S.C. § 103(a) over Mrozowski ('192) in view of Kennedy ('829):

Claims 13-21 and 27-30 stand rejected as being unpatentable over Mrozowski ('192) in view of U.S. Patent 1,864,829 to Kennedy (hereinafter Kennedy ('829)) under 35 U.S.C. § 103(a).

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

With regards to independent claim 13, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "material extending past a lug which supports the tire in a manner to permit the tire to rotate and be aligned with the lug, wherein said material is capable of supporting the tire throughout the positions through which said tire support can travel about the horizontal axis, thereby enabling tire rotation at any of the positions." Examiner states that it would have been obvious to one of ordinary skill in the art to provide discrete arcuate flanges as taught by Kennedy ('829) on the mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Kennedy ('829) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The discrete arcuate flanges taught by Kennedy ('829) when placed on the mounting box of Mrozowski ('192), will not support the tire or enable tire rotation throughout the positions through which the mounting box travels because of the flipping motion of the mounting box (*See* Figures 6 & 15 of Kennedy ('829)). In this regard, the discrete arcuate flanges taught by Kennedy ('829) provide no more, and perhaps less, functionality than the frusto-conical hub taught by Mrozowski ('192). Applicant respectfully submits that claim 13 is allowable over Mrozowski ('192) and Kennedy ('829) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 13 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a). Claims 14-18 are all dependent upon independent claim 13 and are allowable over Mrozowski ('192) and Kennedy ('829) for at least the same reasons as claim 13. Applicant respectfully requests that the

Examiner withdraw the rejections of claims 14-18 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a).

With regards to independent claim 19, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of material extending past a lug which supports a tire in a manner to permit the tire to rotate and be aligned with the lug, the support being provided throughout the positions through which a pivot arm can travel about a horizontal axis, thereby enabling tire rotation at any of the positions. Examiner states that it would have been obvious to one of ordinary skill in the art to provide discrete arcuate flanges as taught by Kennedy ('829) on the mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Kennedy ('829) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The discrete arcuate flanges taught by Kennedy ('829), when placed on the mounting box of Mrozowski ('192), will not support the tire or enable tire rotation throughout the positions through which the secondary rack of Mrozowski ('192) travels because of the flipping motion of the secondary rack (*See* Figures 6 & 15 of Kennedy ('829)). In this regard, the discrete arcuate flanges taught by Kennedy ('829) provide no more, and perhaps less, functionality than the frusto-conical hub taught by Mrozowski ('192). Applicant respectfully submits that claim 19, as amended, is allowable over Mrozowski ('192) and Kennedy ('829) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 19 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a). Claim 21 is dependent upon independent claim 19 and is allowable over Mrozowski ('192) and Kennedy ('829) for at least the same reasons as claim 19. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a).

With regards to independent claim 27, Mrozowski ('192), as previously discussed, fails to teach the claimed subject matter of "a tire support affixed to a distal end of a pivot arm." Examiner states that it would have been obvious to one of ordinary skill in the art to provide discrete arcuate flanges as taught by Kennedy ('829) on the mounting box of Mrozowski ('192) to provide an alternative mounting means. Even if the Examiner's suggested combination of Mrozowski ('192) and Kennedy ('829) were to be made, the combination would still fail to teach or suggest all of the claim limitations. MPEP § 2143. The mounting box of Mrozowski ('192)

will still be located **in the middle of** the secondary rack. Not at an **end** of the secondary rack. Applicant respectfully submits that claim 27 is allowable over Mrozowski ('192) and Kennedy ('829) for at least the foregoing reasons. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a). Claims 28-30 are dependent upon independent claim 27 and are allowable over Mrozowski ('192) and Kennedy ('829) for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejections of claims 28-30 for being unpatentable over Mrozowski ('192) in view of Kennedy ('829) under § 103(a).

Rejection of claims 13-21 and 27-37 under 35 U.S.C. § 103(a) over Jozefczak ('371) in view of JP 258755:

Claims 13-21 and 27-37 stand rejected as being unpatentable over Jozefczak ('371) in view of Japanese Application Publication 08-258755 (hereinafter JP 258755) under 35 U.S.C. § 103(a).

Broadly, Jozefczak ('371) teaches a spare tire carrier mounted to the rear of a vehicle comprising tubular frame pivotally attached to a rear corner of a vehicle. A swing-down device on the tubular frame lowers a spare tire from a raised position to a lowered position on the ground. The swing down device comprises an arm pivotally attached to the tubular frame for pivotal movement between raised and lowered positions, a tire support plate which supports the tire, a support plate latch which secures the support plate to the frame so as to maintain the tire in the raised position, and an assist arm attached at the top of the support plate pivotal between stowed and open positions for use in raising and lowering the tire (Figures 1, 4 & 5, col. 3 line 26-col.4 line 7, and col. 5 line 12-col. 6 line 8). As can be best understood from the figures and the description the tire is attached to the support plate through threaded studs attached to a mechanism extending from the support plate into the well of the rim of the tire (Figures 1 & 5, col. 4 lines 51-53).

Jozefczak ('371) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

JP 258755 discloses a spare tire mounting structure comprising a carrier attached to a vehicle. The carrier has a plurality of carrier bolts passing through mounting holes in the rim of

the tire that secure the spare tire to the carrier. A support rod extends from the carrier in the center of the carrier bolts. The support rod engages an auxiliary plate also attached to the rim of the tire by bolts passing through mounting holes in the rim of the tire. In operation the auxiliary plate is attached to the rim of the tire. The auxiliary plate is then slid over the support rod with the tire attached, so that the tire can be rotated in order to align the bolts of the carrier with the appropriate mounting holes in the rim of the tire (Figures 1-3 and paragraphs [0010]-[0018] of the English translation).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Jozefczak ('371) to incorporate the mounting structure taught by JP 258755 in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered **as a whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Jozefczak ('371) to incorporate the mounting taught by JP 258755 in order to provide an

alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Jozefczak ('371) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Jozefczak ('371) and JP 258755. Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Jozefczak ('371) and JP 258755 and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that a modifying Jozefczak ('371) to incorporate an attachment means as taught by JP 258755 would **not be desirable** at all. JP 258755 does not simply teach placing a tire rim on a support rod or tire spinner. Rather a user, before placing the tire on the tire support, has to attach an auxiliary plate to the tire rim. The auxiliary plate engages the support rod so that the tire can be rotated to align with the carrier bolts. Incorporating the teachings of JP 258755 into the spare tire carrier of Jozefczak ('371) would not only lead to further material costs in terms of providing an auxiliary plate, it would also require extra steps in the process of removing a spare tire from the carrier and placing a tire on the carrier (JP 258755: Figures 1-3 and paragraphs [0010]-[0018] of the English translation). As it stands, a user of the carrier of Jozefczak ('371) can remove and replace a tire on the carrier "with ease" by simply attaching the tire to the plate through threaded studs (Jozefczak ('371): col. 2 lines 59-62, col. 4 lines 51-53). If the teachings of JP 258755 were incorporated into the tire carrier of Jozefczak ('371) a user would not only have to attach or disattach the spare tire via the threaded studs, the user would also have to disattach the auxiliary plate from the spare tire before the tire could be used and attach the auxiliary plate to the spare tire before the tire could be attached to the support plate. Because of this further complication, one of ordinary skill in the art would not find a combination of Jozefczak ('371) and JP 258755 to be desirable or to hold any particular advantage over the carrier of Jozefczak ('371) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary

skill in art in light of the teachings of Jozefczak ('371) and JP 258755 and the rejection is therefore improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21 and 27-37 are allowable over Jozefczak ('371) and JP 258755. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21 and 27-37 as being unpatentable over Jozefczak ('371) in view of JP 258755 under 35 U.S.C. § 103(a).

Rejection of claims 13-21 and 27-37 under 35 U.S.C. § 103(a) over Jozefczak ('371) in view of JP 315351:

Claims 13-21 and 27-30 stand rejected as being unpatentable over Jozefczak ('371) in view of Japanese Application Publication 09-315351 (hereinafter JP 315351) under 35 U.S.C. § 103(a).

Broadly, Jozefczak ('371) teaches a spare tire carrier mounted to the rear of a vehicle comprising tubular frame pivotally attached to a rear corner of a vehicle. A swing-down device on the tubular frame lowers a spare tire from a raised position to a lowered position on the ground. The swing down device comprises an arm pivotally attached to the tubular frame for pivotal movement between raised and lowered positions, a tire support plate which supports the tire, a support plate latch which secures the support plate to the frame so as to maintain the tire in the raised position, and an assist arm attached at the top of the support plate pivotal between stowed and open positions for use in raising and lowering the tire (Figures 1, 4 & 5, col. 3 line 26-col.4 line 7, and col. 5 line 12-col. 6 line 8). As can be best understood from the figures and the description the tire is attached to the support plate through threaded studs attached to a mechanism extending from the support plate into the well of the rim of the tire (Figures 1 & 5, col. 4 lines 51-53).

Jozefczak ('371) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

JP 315351 teaches a tire cover. The cover comprises a cover member having a fixing device attached to the cover on the inside of the cover. The fixing device attaches the cover to a threaded stud protruding from a tire carrier on the vehicle and the cover is then arranged around

a spare tire. The threaded stud protrudes from the tire carrier through an interior opening of the rim of the tire but does not engage the interior opening or provide support for the tire (Figure 1).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Jozefczak ('371) to incorporate the mounting structure taught by JP 315351 in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered as a **whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Jozefczak ('371) to incorporate the mounting taught by JP 315351 in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Jozefczak ('371) by welding the

tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Jozefczak ('371) and JP 315351. Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Jozefczak ('371) and JP 315351 and the rejection is therefore improper.

With regards to independent claim 13, the claim recites the limitation of "material extending past the lug which **supports** the tire in manner to permit the tire to rotate and be **aligned** with the lug." In the rejection the Examiner suggests modifying Jozefczak ('371) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Jozefczak ('371) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire, moreover the threaded stud does not serve to align the rim with the lugs extending from the carrier due to its smaller circumference. Applicant respectfully submits, then, that the combination of Jozefczak ('371) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 13 is therefore improper. Claims 14-18 all depend from independent claim 13. Applicant respectfully submits that the rejection of these claims is also improper.

With regards to independent claim 19, the claim recites the limitation of "material extending past the lug which **supports** the tire in manner to permit the tire to rotate and be **aligned** with the lug." In the rejection the Examiner suggests modifying Jozefczak ('371) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Jozefczak ('371) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire, moreover the threaded stud does not serve to align the rim with the lugs extending from the carrier due to its smaller circumference. Applicant respectfully submits, then, that the

combination of Jozefczak ('371) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 19 is therefore improper. Claim 21 depends from independent claim 19. Applicant respectfully submits that the rejection of this claim is also improper.

With regards to independent claim 27, the claim recites the limitation of a "[tire] spinner comprising material attached to and extending from said tire support, **thereby supporting** a tire in a manner permitting tire rotation." In the rejection the Examiner suggests modifying Jozefczak ('371) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Jozefczak ('371) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire. Applicant respectfully submits, then, that the combination of Jozefczak ('371) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 27 is therefore improper. Claims 28-37 all depend from independent claim 27. Applicant respectfully submits that the rejection of these claims is also improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21 and 27-37 are allowable over Jozefczak ('371) and JP 315351. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21 and 27-37 as being unpatentable over Jozefczak ('371) in view of JP 315351 under 35 U.S.C. § 103(a).

Rejection of claims 13-21 and 27-37 under 35 U.S.C. § 103(a) over Jozefczak ('371) in view of Kennedy ('829):

Claims 13-21 and 27-30 stand rejected as being unpatentable over Jozefczak ('371) in view of Kennedy ('829) under 35 U.S.C. § 103(a).

Broadly, Jozefczak ('371) teaches a spare tire carrier mounted to the rear of a vehicle comprising tubular frame pivotally attached to a rear corner of a vehicle. A swing-down device on the tubular frame lowers a spare tire from a raised position to a lowered position on the ground. The swing down device comprises an arm pivotally attached to the tubular frame for pivotal movement between raised and lowered positions, a tire support plate which supports the tire, a support plate latch which secures the support plate to the frame so as to maintain the tire in the raised position, and an assist arm attached at the top of the support plate pivotal between

stowed and open positions for use in raising and lowering the tire (Figures 1, 4 & 5, col. 3 line 26-col.4 line 7, and col. 5 line 12-col. 6 line 8). As can be best understood from the figures and the description the tire is attached to the support plate through threaded studs attached to a mechanism extending from the support plate into the well of the rim of the tire (Figures 1 & 5, col. 4 lines 51-53).

Jozefczak ('371) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

Kennedy ('829) teaches a spare tire carrier for road vehicles. The carrier comprises two arms that lower a tire to the ground through use of a winch assembly. In one embodiment a tire is mounted to one of the arms by four curved flanges disposed on a tire support. The flanges are provided with lugs having bolts. In use the central aperture of the rim of the wheel is engaged by the curved flanges and the wheel is then secured by bolting the wheel to the lugs (Figures 6, 9 & 15, page 3 lines 58-64).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Jozefczak ('371) to incorporate the mounting structure taught by Kennedy ('829) in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered as a **whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some

suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Jozefczak ('371) to incorporate the mounting taught by Kennedy ('829) in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Jozefczak ('371) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Jozefczak ('371) and Kennedy ('829). Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Jozefczak ('371) and Kennedy ('829) and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that a modifying Jozefczak ('371) to incorporate an attachment means as taught by Kennedy ('829) would **not be desirable** at all. As can be seen from Figure 15 of Kennedy ('829) the portion of the flanges that engages the interior opening extends past the length of the lugs by only the slightest amount, if at all. A person attaching a tire to the structure of Kennedy ('829) must have to remove the lugs from the flanges, place the tire on the flanges, and then replace the lugs by passing them through the flanges and openings in the rim of the tire. As it stands, a user of the carrier of Jozefczak ('371) can remove and replace a tire on the carrier "with ease" by simply attaching the tire to the plate through threaded studs (Jozefczak ('371): col. 2 lines 59-62, col. 4 lines 51-53). As can be seen from Figures 1, 4 and 5 of Jozefczak ('371) the support plate covers a significant portion of the inner

well of the wheel and abuts against the tire thus significantly obstructing access to the inner well of the wheel when the wheel is mounted to the support plate. If the teachings of Kennedy ('829) were incorporated into the tire carrier of Jozefczak ('371) a user, in order to mount a tire onto the carrier, would somehow have to reach into the inner well of the wheel around the support plate, which is not offset from the tire at all, and the mounting apparatus to remove the lugs from the curved flanges. The user would then have to walk around to the opposite side of the carrier and place the tire on the curved flanges. The user would then have to walk back to the other side of the carrier and once again reach around the support plate and mounting apparatus to replace the lugs on the flanges. One wonders if this is even possible given the lack of spacing between the support plate and the tire, the size of the support plate compared to the size of the wheel well, and the presence of the mounting apparatus. Because of this complication, one of ordinary skill in the art would not find a combination of Jozefczak ('371) and Kennedy ('829) to be desirable or to hold any particular advantage over the carrier of Jozefczak ('371) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary skill in art in light of the teachings of Jozefczak ('371) and Kennedy ('829) and the rejection is therefore improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21 and 27-37 are allowable over Jozefczak ('371) and Kennedy ('829). Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21 and 27-37 as being unpatentable over Jozefczak ('371) in view of Kennedy ('829) under 35 U.S.C. § 103(a).

**Rejection of claims 13-21 and 27-30 under 35 U.S.C. § 103(a)
over Jozefczak ('371) in view of Hansen ('717):**

Claims 13-21 and 27-30 stand rejected as being unpatentable over Jozefczak ('371) in view of Hansen ('717) under 35 U.S.C. § 103(a).

Broadly, Jozefczak ('371) teaches a spare tire carrier mounted to the rear of a vehicle comprising tubular frame pivotally attached to a rear corner of a vehicle. A swing-down device on the tubular frame lowers a spare tire from a raised position to a lowered position on the ground. The swing down device comprises an arm pivotally attached to the tubular frame for pivotal movement between raised and lowered positions, a tire support plate which supports the tire, a support plate latch which secures the support plate to the frame so as to maintain the tire in the raised position, and an assist arm attached at the top of the support plate pivotal between

stowed and open positions for use in raising and lowering the tire (Figures 1, 4 & 5, col. 3 line 26-col.4 line 7, and col. 5 line 12-col. 6 line 8). As can be best understood from the figures and the description the tire is attached to the support plate through threaded studs attached to a mechanism extending from the support plate into the well of the rim of the tire (Figures 1 & 5, col. 4 lines 51-53).

Jozefczak ('371) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

Hansen ('717) teaches a spare tire carrier comprising a plate attached to an arm that pivots about a hinge away from the rear of a vehicle. A tire is attached to the plate through threaded studs projecting from the plate. Also projecting from the plate is an arcuate rest concentric with the plate. The threaded studs are arranged in a bolt circle concentric with the plate. In use the rim of a tire is placed on the plate with the interior opening of the rim engaging the arcuate rest. The tire is then rotated on the arcuate rest until the threaded studs align with lug bolt openings in the rim of the tire. The arcuate rest extends about its own circumference for an angle significantly less than 180° and the center of the arcuate rest is oriented upward when the tire is stowed on the rear of the vehicle (Figure 1, col. 5 lines 8-34).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Jozefczak ('371) to incorporate the mounting structure taught by Hansen ('717) in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered **as a whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Jozefczak ('371) to incorporate the mounting taught by Hansen ('717) in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Jozefczak ('371) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Jozefczak ('371) and Hansen ('717). Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Jozefczak ('371) and Hansen ('717) and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that a modifying Jozefczak ('371) to incorporate an attachment means as taught by Hansen ('717) would **not be desirable** at all. As can be seen from Figure 1 of Hansen ('717) the arcuate rest extends for significantly less than 180° of its circumference the center of the arcuate rest is oriented upward when a tire is fully stowed. Figures 1 and 5 of Jozefczak ('371) show the orientation of the support plate when the support plate is in the raised and lowered positions respectively. If the teachings of Hansen

('717) were incorporated into the tire carrier of Jozefczak ('371) the arcuate rest would be oriented substantially downward when the support plate is in the lowered position given the angle that the support plate travels through when passing between the raised and lowered positions. The arcuate rest would provide no support for the tire as the tire is mounted onto the support plate of Jozefczak ('371). Therefore, incorporating the mounting structure of Hansen ('717) into the carrier of Jozefczak ('371) would provide no further functionality to the carrier of Jozefczak ('371) and only serve to add to the material cost of the carrier. Because of this lack of added functionality, one of ordinary skill in the art would not find a combination of Jozefczak ('371) and Hansen ('717) to be desirable or to hold any particular advantage over the carrier of Jozefczak ('371) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary skill in art in light of the teachings of Jozefczak ('371) and Hansen ('717) and the rejection is therefore improper.

With regards to independent claim 13, the claim recites the limitation of "material extending past the lug which supports the tire in manner to permit the tire to rotate and be aligned with the lug, wherein said material is capable of supporting the tire **throughout the positions through which said tire support can travel** about the horizontal axis." In the rejection the Examiner suggests modifying Jozefczak ('371) to incorporate the mounting structure taught by Hansen ('717) to meet the claimed subject matter. Applicant respectfully submits that the combination of Jozefczak ('371) and Hansen ('717) fails to teach the above-mentioned claimed subject matter. As previously discussed, if the mounting structure of Hansen ('717) were to be incorporated into the carrier of Jozefczak ('371) the arcuate rest would be oriented **substantially downward** when the support plate is in the lowered position. As such, the arcuate rest would provide **no support** for the tire when support plate is in the lowered position. Applicant respectfully submits, then, that the combination of Jozefczak ('371) and Hansen ('717) fails to teach or suggest all of the claim limitations and the rejection of independent claim 13 is therefore improper. Claims 14-18 all depend from independent claim 13. Applicant respectfully submits that the rejection of these claims is also improper.

With regards to independent claim 19, the claim, as amended, recites the limitation of "said support is provided throughout the positions through which a pivot arm can travel about said horizontal axis." In the rejection the Examiner suggests modifying Jozefczak ('371) to incorporate the mounting structure taught by Hansen ('717) to meet the claimed subject matter.

Applicant respectfully submits that the combination of Jozefczak ('371) and Hansen ('717) fails to teach the above-mentioned claimed subject matter. As previously discussed, if the mounting structure of Hansen ('717) were to be incorporated into the carrier of Jozefczak ('371) the arcuate rest would be oriented **substantially downward** when the arm is in the lowered position. As such, the arcuate rest would provide **no support** for the tire when the arm is in the lowered position. Applicant respectfully submits, then, that the combination of Jozefczak ('371) and Hansen ('717) fails to teach or suggest all of the claim limitations and the rejection of independent claim 19 is therefore improper. Claim 21 depends from independent claim 19. Applicant respectfully submits that the rejection of this claim is also improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21 and 27-30 are allowable over Jozefczak ('371) and Hansen ('717). Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21 and 27-30 as being unpatentable over Jozefczak ('371) in view of Hansen ('717) under 35 U.S.C. § 103(a).

Rejection of claims 13-21, 27-31 and 33-37 under 35 U.S.C. § 103(a) over Newbill ('318) in view of JP 258755:

Claims 13-21, 27-31 and 33-37 stand rejected as being unpatentable over U.S. Patent 6,659,318 to Newbill (hereinafter Newbill ('318)) in view of JP 258755 under 35 U.S.C. § 103(a).

Broadly, Newbill ('318) teaches a spare wheel carrier attached at the rear of a vehicle for carrying a spare wheel. A box beam is hingedly attached to the rear bumper of the vehicle. A wheel assembly support arm is pivotally attached to the box beam and serves to lower a spare wheel from a raised position to a lowered position on the ground. The support arm terminates at its distal end in a cross member. The cross member is apertured to receive bolts that pass through the cross member and lug nut openings in the tire to secure the tire to the cross member. In operation carrier is swung away from the rear of a vehicle and the arm is lowered to place the tire on the ground. The tire is then removed from the cross member by unsecuring the bolts (Figures 1-3, col. 2 line 60-col. 3 line 32).

Newbill ('318) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

JP 258755 discloses a spare tire mounting structure comprising a carrier attached to a vehicle. The carrier has a plurality of carrier bolts passing through mounting holes in the rim of the tire that secure the spare tire to the carrier. A support rod extends from the carrier in the center of the carrier bolts. The support rod engages an auxiliary plate also attached to the rim of the tire by bolts passing through mounting holes in the rim of the tire. In operation the auxiliary plate is attached to the rim of the tire. The auxiliary plate is then slid over the support rod with the tire attached, so that the tire can be rotated in order to align the bolts of the carrier with the appropriate mounting holes in the rim of the tire (Figures 1-3 and paragraphs [0010]-[0018] of the English translation).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Newbill ('318) to incorporate the mounting structure taught by JP 258755 in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered **as a whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The

Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify Newbill ('318) to incorporate the mounting taught by JP 258755 in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Newbill ('318) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Newbill ('318) and JP 258755. Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Newbill ('318) and JP 258755 and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that a modifying Newbill ('318) to incorporate an attachment means as taught by JP 258755 would **not be desirable** at all. JP 258755 does not simply teach placing a tire rim on a support rod or tire spinner. Rather a user, before placing the tire on the tire support, has to attach an auxiliary plate to the tire rim. The auxiliary plate engages the support rod so that the tire can be rotated to align with the carrier bolts. Incorporating the teachings of JP 258755 into the spare wheel carrier of Newbill ('318) would not only lead to further material costs in terms of providing an auxiliary plate, it would also require extra steps in the process of removing a spare tire from the carrier and placing a tire on the carrier (JP 258755: Figures 1-3 and paragraphs [0010]-[0018] of the English translation). As it stands, a user of the carrier of Newbill ('318) can remove and replace a tire on the carrier by simply attaching the tire to the cross member through bolts (Newbill ('318): Figures 1-3 and col. 3 lines 5-32). If the teachings of JP 258755 were incorporated into the wheel carrier of Newbill ('318) a user would not only have to attach or disattach the spare tire via the bolts, the user would also have to disattach the auxiliary plate from the spare tire before the tire could be used and attach the auxiliary plate to the spare tire before the tire could be attached to the cross member. Because of this further complication, one of ordinary skill in the art would not find a combination of Newbill ('318) and JP 258755 to be desirable or to hold any particular advantage

over the carrier of Newbill ('318) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary skill in art in light of the teachings of Newbill ('318) and JP 258755 and the rejection is therefore improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21, 27-31 and 33-37 are allowable over Newbill ('318) and JP 258755. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21, 27-31 and 33-37 as being unpatentable over Newbill ('318) in view of JP 258755 under 35 U.S.C. § 103(a).

Rejection of claims 13-21, 27-31 and 33-37 under 35 U.S.C. § 103(a) over Newbill ('318) in view of JP 315351:

Claims 13-21, 27-31 and 33-37 stand rejected as being unpatentable over Newbill ('318) in view of JP 315351 under 35 U.S.C. § 103(a).

Broadly, Newbill ('318) teaches a spare wheel carrier attached at the rear of a vehicle for carrying a spare wheel. A box beam is hingedly attached to the rear bumper of the vehicle. A wheel assembly support arm is pivotally attached to the box beam and serves to lower a spare wheel from a raised position to a lowered position on the ground. The support arm terminates at its distal end in a cross member. The cross member is apertured to receive bolts that pass through the cross member and lug nut openings in the tire to secure the tire to the cross member. In operation carrier is swung away from the rear of a vehicle and the arm is lowered to place the tire on the ground. The tire is then removed from the cross member by unsecuring the bolts (Figures 1-3, col. 2 line 60-col. 3 line 32).

Newbill ('318) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

JP 315351 teaches a tire cover. The cover comprises a cover member having a fixing device attached to the cover on the inside of the cover. The fixing device attaches the cover to a threaded stud protruding from a tire carrier on the vehicle and the cover is then arranged around a spare tire. The threaded stud protrudes from the tire carrier through an interior opening of the rim of the tire but does not engage the interior opening or provide support for the tire (Figure 1).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Newbill ('318) to incorporate the mounting structure taught

by JP 315351 in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered **as a whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Newbill ('318) to incorporate the mounting taught by JP 315351 in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Newbill ('318) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Newbill ('318) and JP 315351. Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the

suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Newbill ('318) and JP 315351 and the rejection is therefore improper.

With regards to independent claim 13, the claim recites the limitation of "material extending past the lug which **supports** the tire in manner to permit the tire to rotate and be **aligned** with the lug." In the rejection the Examiner suggests modifying Newbill ('318) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Newbill ('318) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire, moreover the threaded stud does not serve to align the rim with the lugs extending from the carrier due to its smaller circumference. Applicant respectfully submits, then, that the combination of Newbill ('318) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 13 is therefore improper. Claims 14-18 all depend from independent claim 13. Applicant respectfully submits that the rejection of these claims is also improper.

With regards to independent claim 19, the claim recites the limitation of "material extending past the lug which **supports** the tire in manner to permit the tire to rotate and be **aligned** with the lug." In the rejection the Examiner suggests modifying Newbill ('318) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Newbill ('318) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire, moreover the threaded stud does not serve to align the rim with the lugs extending from the carrier due to its smaller circumference. Applicant respectfully submits, then, that the combination of Newbill ('318) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 19 is therefore improper. Claim 21 depends from independent claim 19. Applicant respectfully submits that the rejection of this claim is also improper.

With regards to independent claim 27, the claim recites the limitation of a “[tire] spinner comprising material attached to and extending from said tire support, **thereby supporting** a tire in a manner permitting tire rotation.” In the rejection the Examiner suggests modifying Newbill (‘318) to incorporate the mounting structure taught by JP 315351 to meet the claimed subject matter. Applicant respectfully submits that the combination of Newbill (‘318) and JP 315351 fails to teach the above-mentioned claimed subject matter. As can be seen from Figure 1 of JP 315351, the threaded stud extending from the tire carrier of JP 315351 is smaller than the interior opening of the tire rim and does not engage the interior opening in order to provide support for the tire. Applicant respectfully submits, then, that the combination of Newbill (‘318) and JP 315351 fails to teach or suggest all of the claim limitations and the rejection of independent claim 27 is therefore improper. Claims 28-31 and 33-37 all depend from independent claim 27. Applicant respectfully submits that the rejection of these claims is also improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21, 27-31 and 33-37 are allowable over Newbill (‘318) and JP 315351. Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21, 27-31 and 33-37 as being unpatentable over Newbill (‘318) in view of JP 315351 under 35 U.S.C. § 103(a).

Rejection of claims 13-21, 27-31 and 33-37 under 35 U.S.C. § 103(a) over Newbill (‘318) in view of Hansen (‘717):

Claims 13-21, 27-31 and 33-37 stand rejected as being unpatentable over Newbill (‘318) in view of Hansen (‘717) under 35 U.S.C. § 103(a).

Broadly, Newbill (‘318) teaches a spare wheel carrier attached at the rear of a vehicle for carrying a spare wheel. A box beam is hingedly attached to the rear bumper of the vehicle. A wheel assembly support arm is pivotally attached to the box beam and serves to lower a spare wheel from a raised position to a lowered position on the ground. The support arm terminates at its distal end in a cross member. The cross member is apertured to receive bolts that pass through the cross member and lug nut openings in the tire to secure the tire to the cross member. In operation the carrier is swung away from the rear of a vehicle and the arm is lowered to place the tire on the ground. The tire is then removed from the cross member by unsecuring the bolts (Figures 1-3, col. 2 line 60-col. 3 line 32).

Newbill (‘318) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a

tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

Hansen ('717) teaches a spare tire carrier comprising a plate attached to an arm that pivots about a hinge away from the rear of a vehicle. A tire is attached to the plate through threaded studs projecting from the plate. Also projecting from the plate is an arcuate rest concentric with the plate. The threaded studs are arranged in a bolt circle concentric with the plate. In use the rim of a tire is placed on the plate with the interior opening of the rim engaging the arcuate rest. The tire is then rotated on the arcuate rest until the threaded studs align with lug bolt openings in the rim of the tire. The arcuate rest extends about its own circumference for an angle significantly less than 180° and the center of the arcuate rest is oriented upward when the tire is stowed on the rear of the vehicle (Figure 1, col. 5 lines 8-34).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Newbill ('318) to incorporate the mounting structure taught by Hansen ('717) in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered as a **whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings

of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify Newbill ('318) to incorporate the mounting taught by Hansen ('717) in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Newbill ('318) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Newbill ('318) and Hansen ('717). Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Newbill ('318) and Hansen ('717) and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that modifying Newbill ('318) to incorporate an attachment means as taught by Hansen ('717) would **not be desirable** at all. As can be seen from Figure 1 of Hansen ('717) the arcuate rest extends for significantly less than 180° of its circumference the center of the arcuate rest is oriented upward when a tire is fully stowed. Figure 1 of Newbill ('318) shows the orientation of the cross member when the cross member is in the raised and lowered positions. If the teachings of Hansen ('717) were incorporated into the wheel carrier of Newbill ('318) the arcuate rest would be oriented substantially to the side when the cross member is in the lowered position given the angle that the cross member travels through when passing between the raised and lowered positions. The arcuate rest would provide little support for the tire as the tire is mounted onto the cross member of Newbill ('318). Therefore, incorporating the mounting structure of Hansen ('717) into the carrier of Newbill ('318) would provide little further functionality to the carrier of Newbill ('318) and only serve to add to the material cost of the carrier. Because of this lack of added functionality, one of ordinary skill in the art would not find a combination of Newbill ('318) and Hansen ('717) to be desirable or to

hold any particular advantage over the carrier of Newbill ('318) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary skill in art in light of the teachings of Newbill ('318) and Hansen ('717) and the rejection is therefore improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21, 27-31 and 33-37 are allowable over Newbill ('318) and Hansen ('717). Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21, 27-31 and 33-37 as being unpatentable over Newbill ('318) in view of Hansen ('717) under 35 U.S.C. § 103(a).

Rejections of claim 32 under 35 U.S.C. § 103(a):

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of JP 258755 and further in view of U.S. Patent 4,047,629 to Klein (hereinafter Klein ('629)) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and JP 258755 as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of JP 258755 and further in view of Klein ('629).

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of JP 258755 and further in view of Kennedy ('829) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and JP 258755 as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of JP 258755 and further in view of Kennedy ('829).

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of JP 315351 and further in view of Klein ('629) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and JP 315351 as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of JP 315351 and further in view of Klein ('629).

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of JP 315351 and further in view of Kennedy ('829) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and JP 315351 as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of JP 315351 and further in view of Kennedy ('829).

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of Hansen ('717) and further in view of Klein ('629) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and Hansen ('717) as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of Hansen ('717) and further in view of Klein ('629).

Claim 32 stands rejected as being unpatentable over Newbill ('318) in view of Hansen ('717) and further in view of Kennedy ('829) under 35 U.S.C. § 103(a). With regards to this rejection, claim 32 is dependent upon independent claim 27. Applicant respectfully submits that claim 27 is allowable over Newbill ('318) and Hansen ('717) as established above. Claim 32 is also allowable, then, for at least the same reasons as claim 27. Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as being unpatentable over Newbill ('318) in view of Hansen ('717) and further in view of Kennedy ('829).

Rejection of claims 13-21 and 27-37 under 35 U.S.C. § 103(a) over Newbill ('318) in view of Kennedy ('829):

Claims 13-21 and 27-37 stand rejected as being unpatentable over Newbill ('318) in view of Kennedy ('829) under 35 U.S.C. § 103(a).

Broadly, Newbill ('318) teaches a spare wheel carrier attached at the rear of a vehicle for carrying a spare wheel. A box beam is hingedly attached to the rear bumper of the vehicle. A wheel assembly support arm is pivotally attached to the box beam and serves to lower a spare wheel from a raised position to a lowered position on the ground. The support arm terminates at its distal end in a cross member. The cross member is apertured to receive bolts that pass through the cross member and lug nut openings in the tire to secure the tire to the cross member. In

operation the carrier is swung away from the rear of a vehicle and the arm is lowered to place the tire on the ground. The tire is then removed from the cross member by unsecuring the bolts (Figures 1-3, col. 2 line 60-col. 3 line 32).

Newbill ('318) does not teach the currently claimed subject matter of material extending past a lug which supports the tire in a manner permitting tire rotation (claims 13 and 19) or of a tire spinner comprising material attached to extending away from a tire support, thereby supporting a tire in a manner permitting tire rotation (claim 27).

Kennedy ('829) teaches a spare tire carrier for road vehicles. The carrier comprises two arms that lower a tire to the ground through use of a winch assembly. In one embodiment a tire is mounted to one of the arms by four curved flanges disposed on a tire support. The flanges are provided with lugs having bolts. In use the central aperture of the rim of the wheel is engaged by the curved flanges and the wheel is then secured by bolting the wheel to the lugs (Figures 6, 9 & 15, page 3 lines 58-64).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the tire mounting structure of Newbill ('318) to incorporate the mounting structure taught by Kennedy ('829) in order to provide alternative mounting means. As such, according to the Examiner, the subject matter of the current claims is unpatentable.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness three criteria must be met. First, must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143. The teachings of a prior art reference must be considered **as a whole** including those portions that would lead away from the claimed invention. MPEP § 2141.02(VI).

With regards to the motivation to combine references, Applicant respectfully submits that the mere fact that prior art references can be combined or modified does not mean that the resulting combination is rendered obvious. The prior art must also suggest the desirability of the combination. MPEP § 2143.01(III). The initial burden is on the Examiner to provide some suggestion of the desirability of making the combination. To support a conclusion that claimed subject matter is obvious the combined references must either expressly or impliedly suggest the

claimed invention or the Examiner must set forth a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. When the motivation to combine reference teachings is not readily apparent, it is the Examiner's duty to explain why the combination would be proper. MPEP § 2142. The Examiner asserts that it would have been obvious to one ordinary skill in the art to modify Newbill ('318) to incorporate the mounting taught by Kennedy ('829) in order to provide an alternate mounting means. Applicant respectfully submits that such a motivation is insufficient to render the claimed subject matter obvious and does not indicate the desirability of the combination. One of ordinary skill in the art would not be motivated to combine reference teachings just for the purpose of providing alternate mounting means. For example, the prior art teaches welding as a means of attachment. One could modify Newbill ('318) by welding the tire rim to the support plate. Doing so would provide an alternative mounting means but the combination would clearly not be desirable. The Examiner makes no mention of any actual desirability of combining the teachings of Newbill ('318) and Kennedy ('829). Applicant respectfully submits, then, that the Examiner has failed to meet the Examiner's burden of establishing the desirability of the suggested combination and providing a convincing reason as to why one of ordinary skill in the art would have found the claimed subject matter obvious in light of the teachings of Newbill ('318) and Kennedy ('829) and the rejection is therefore improper.

Furthermore, Applicant respectfully submits that a modifying Newbill ('318) to incorporate an attachment means as taught by Kennedy ('829) would **not be desirable** at all. As can be seen from Figure 15 of Kennedy ('829) the portion of the flanges that engages the interior opening extends past the length of the lugs by only the slightest amount, if at all. A person attaching a tire to the structure of Kennedy ('829) must have to remove the lugs from the flanges, place the tire on the flanges, and then replace the lugs by passing them through the flanges and openings in the rim of the tire. As it stands, a user of the carrier of Newbill ('318) can remove and replace a tire on the carrier by simply attaching the tire to the cross member through bolts (Newbill ('318): Figures 1-3 and col. 3 lines 5-32). If the teachings of Kennedy ('829) were incorporated into the tire carrier of Newbill ('318) a user, in order to mount a tire onto the carrier, would have to remove the bolts from the curved flanges. The user would then have to walk around to the opposite side of the carrier and place the tire on the curved flanges. The user

would then have to walk back to the other side of the carrier and replace the bolts on the flanges. Moreover, as can be seen from Figures 1 and 3 of Newbill ('318) the cross member is smaller in width than the diameter of the interior opening of the rim. The cross member does not cover the entire interior opening. Kennedy ('829) teaches four discrete, equally spaced curved flanges that engage the interior opening of the rim. The cross member of Newbill ('318) is not large enough to accommodate four flanges that all engage the interior opening of the rim because the cross member is not as wide as the interior opening of the rim. One would either have to modify the cross member with only two flanges, which, given their small relative size, would probably be insufficient to fully support the tire without the bolts or modify Newbill ('318) to also incorporate the support hub taught by Kennedy ('829) as well, which, given its size and complex shape compared to the cross member of Newbill ('318), would greatly add to the material cost of the carrier and increase the overall weight of the carrier making the carrier more difficult to use. Because of these complications, one of ordinary skill in the art would not find a combination of Newbill ('318) and Kennedy ('829) to be desirable or to hold any particular advantage over the carrier of Newbill ('318) as taught. Applicant respectfully submits, then, that the subject matter of the current claims **cannot** be obvious to one of ordinary skill in art in light of the teachings of Newbill ('318) and Kennedy ('829) and the rejection is therefore improper.

For the foregoing reasons, Applicant respectfully submits that claims 13-19, 21 and 27-37 are allowable over Newbill ('318) and Kennedy ('829). Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-19, 21 and 27-37 as being unpatentable over Newbill ('318) in view of Kennedy ('829) under 35 U.S.C. § 103(a).

Request for Interview:

The Examiner has objected to the drawings and has now rejected claims 13-21 under 35 U.S.C. § 112, 1st paragraph because, according to the Examiner, the device currently described and claimed is non-operational. Applicant is honestly bewildered as to the Examiner's continuing objection on these grounds. Especially in light of Applicant's prior remarks addressing these objections, the **burden on the Examiner** in making such objections/rejections over the **strong presumption** that the Application, as filed, is sufficient, and the fact that the Applicant has **already obtained a patent** from an application having the exact same drawings as were originally filed in this application.

Applicant would like to assure the Examiner that the current invention is **most definitely operational** and is currently being used by United States soldiers serving in the Middle East. Applicant has further filed with this Response new drawing sheets further detailing the structure and operation of the current invention as well as a copy of Ibis Tek's online brochure for a commercial embodiment of the current invention.

If after review of these new drawings, the online brochure, and Applicant's remarks set forth above the Examiner is still confused as to the operation of the current invention, Applicant respectfully requests that the Examiner give the undersigned an opportunity for a personal interview with the Examiner at the PTO. The undersigned is willing to bring a spare tire carrier corresponding to the current invention and demonstrate its operation for the Examiner in person in order to alleviate the Examiner's concerns.

The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

In view of the foregoing, it is respectfully submitted that Claims 13, 19 and 27 fully distinguish over the applied art and are thus in condition for allowance. It is also respectfully submitted that dependent Claims 14-18, 21 and 28-37 are also in condition for allowance.

/

/

/

/

/

/

/

/

/

/

/

/

In summary, Claims 13-19, 21 and 27-37 are fully distinguishable over the applied art and immediately allowable. Notice to that effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stanley D. Ference III", written over a horizontal line.

Stanley D. Ference III
Registration No. 33,879

Customer No. 35195
FERENCE & ASSOCIATES
409 Broad Street
Pittsburgh, Pennsylvania 15143
(412) 741-8400
(412) 741-9292 - Facsimile

Attorneys for Applicant